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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,026	09/03/1999	CHARLES A. PEYSER	020748.0103PTUS	6211
7590	12/04/2007		EXAMINER	
IP Department Patton Boggs, LLP Suite 3000 2001 Ross Avenue Dallas, TX 75201			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	
			MAIL DATE	DELIVERY MODE
			12/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/390,026	PEYSER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 October 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 39,45,46,54,55 and 58 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 39,45,46,54,55, and 58 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 

Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)
 

Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. The applicant's amendment received on 10/22/2007 is acknowledged and entered. None of the claims has been currently amended. Claims 1-38 were previously canceled and claims 40-44, 47-53, 56-57 and 59 were previously withdrawn. Currently claims 39, 45-46, 54-55 and 58 are pending.

***Response to Arguments***

2.1. Applicant's election with traverse of claims 39, 45-46, 54-55 and 58 in the reply filed on 10/22/2007 is acknowledged. The traversal is on the ground(s) that the withdrawn claims 40-44, 47-53 further describe features of independent claim 39 and withdrawn claims 56-57 describe features of independent claim 54. However, this is not found persuasive because the examiner disagrees with this traversal and states that while there may be some overlap between the search areas required for both groups of claims, elected and withdrawn, the search is divergent. The features described in claims 40-44, 47-53 constitute species of genus claim 39 which are independent of the features recited in the elected dependencies 45-46. Claims 45-46 recite the features of querying a buyer regarding prior usage whereas. The features in claims 40-44, 47-53 recite generating a plurality of offers from different service providers, specifying the steps of claim 39 to be carried out sequentially, receiving a selection input out of plurality of offers from the buyers, receiving plurality of requests for plurality of telecommunication services, qualifying the buyer, registering the buyer, the request including specific dates, forming

a contract based upon response between the provider and buyer are independent of the features recited in claims 45-46 and would require divergent search for these features which is not needed for features of claims 45-46. Similarly, the features of withdrawn dependent claims 56-57 that is the offer is a plurality of offers from a plurality of service providers and that the response is a collaboration of plurality of responses are independent of the features recited in the elected dependent claim 55 and would require divergent search for these features which is not needed for features of claim 55. Thus it can be clearly seen that the non elected group of claims would require distinct and unduly burdensome and divergent search strategies on the part of the examiner. The requirement is still deemed proper and is therefore made FINAL.

2.2. Applicants arguments filed on 10/22/2007 (see remarks pages 6-7) against rejection of claims 54-55 under 35 USC 101 have been considered but are not persuasive. The examiner does not agree with the applicant's argument that the features of claim 54 produce a useful, concrete and tangible result in the form of generating an offer to a buyer and notifying a provider of a response to the buyer because claim 54 claims a server and a database which can be mere code/software that is a data structure resembling a data file *without executing any functional changes due to an application program and resulting in an useful, concrete and tangible result.* The software program/code, such as claimed server and database, can produce a useful, concrete and tangible result only in combination with a computer readable

medium, which is not explicitly disclosed or taught in claim 54. Therefore, rejection of claims 54-55 under 35 USC 101 are maintained.

2.3. Applicants arguments filed on 10/22/2007 (see remarks pages 7-9) against prior art rejection of claim 39 have been considered but are not persuasive. The arguments presented are similar to the ones presented in the earlier amendment filed on 5/7/2007 which were replied to in the examiner's office action mailed on 7/18/2007. Therefore, the rejection of claims 39 and 54, which include similar features as that of claim 39, under 35 USC 103 (a) as being unpatentable over Walker/Abelow is maintained.

This is a final rejection.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 54-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 54-55 are directed to disembodied data structure which are per se not statutory. C.f. In re Wamerdam. Claims 54-55 claim a server and a database which can

be mere code/software that is a data structure resembling a data file without executing any functional changes due to an application program and resulting in an useful, concrete and tangible result. Functional descriptive material, in combination with a computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system is statutory i.e., a set of instructions in combination with a computer system. C.f. In re Wamerdam - data structure stored in a computer memory, and In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium.

A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete an tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101. Examples of Statutory Functional Descriptive Material are:

- (a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.
- (b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that

a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.58 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39, 45-46, 54-55 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Abelow.

With regards to claim 39, Walker discloses a method for purchasing telecommunication services, comprising:

receiving a request for purchasing at least one telecommunication service at a server, the request being associated with a buyer, generating an offer to provide the at least said telecommunication service to the buyer in response to receiving the request, the offer being associated with a provider of said telecommunication services, receiving a response to the offer, wherein the response is associated with the buyer, and notifying the provider of the response and an identity of the buyer (see at least FIG.1a, ' Calling party 110 " represents buyers' terminals, "CPO management system 100 [see also Fig.3] represents the sever which is requested for the required service by the buyer, and " Inter exchange carrier 1, 2....N" correspond to different providers of services, col.4; tines 39-52, receiving and processing CPOS for telephone calls from one or more calling parties, such as a calling party 110... ;and col.6, line 84-col.7, firm 9 , " ... Figs. 8a and lb, to provide (i) each CPO to the inter exchange carriers 120... ....". Also see col.3, lines 8-67. Note: Walker further discloses that on receiving responses from the number of inter exchange carriers, that is the service providers, the buyer is notified about the offers and if the buyer accepts an offer the contract is completed, that is the seller is informed and services accepted from the seller for said buyer and payment made);

Walker does teach receiving information regarding prior use of telecommunication services of the buyer (see at least col.8, lines 11-28, and col.8, fine 59-col.9, fine 7, "**FIG. 4 illustrates an exemplary customer database 400 that preferably stores Information on each customer (calling party) of the CPO management system 900, Including biographical information and an indication of the local telephone company serving each customer.** ..... customer database 400

includes the customer's address in field 445, the manner in which the customer is bound in field 450, an indication of the local telephone company serving the customer in field 455 and the customer's telephone number in field 460. The telephone number stored in field 460 may be utilized, for example, as a customer identifier to index a historical database (not shown) of previous transactions associated with the customer. " Note: Walker's suggestion of utilizing the stored telephone number Information as a customer identifier to index a historical database correspond to receiving Information about prior use of telecommunication services of the users/buyers).

Walker does not explicitly disclose that the prior use information is received from the buyer and using this information to generate the offer from the provider of services. However, in the same field of endeavor, Abelow discloses using prior use information from the customer/buyer in redesigning and improving the services and products offered to the buyer/customer (see at least Abelow, Fig.1, block "30", " Use customer and user information to redesign and improve products, services", col.6, lines 46-65, col.8, lines 15-32, col.9, lines 38-46, col.12, lines 5-16[refers to telecommunication services, such as interactive home television, electronic books, wireless mobile electronic devices, etc.] and col.18, lines 11-50. Further see at least Fig. 20 [760-Data collection], Fig.25, Fig.27B teach querying users/customers to get feedback with regards to their prior use of products/services). In view of Abelow, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Walker to incorporate the teachings of using prior use information of the buyer in providing telecommunication services/generating offers for telecommunication services to a

potential buyer because, as clearly demonstrated in Abelow, it would help the sellers/suppliers/vendors/manufacturers to incorporate the customer's feedback and provide better and improved designed services/products thus helping businesses to provide more satisfaction and improved services/products to buyers/customers.

Regarding claim 45, its limitations are already covered in the analysis of claim 39 above (see at least Fig. 20 [760-Data collection], Fig.25, and Fig.27B. Abelow teaches querying users/customers to get feedback with regards to their prior use of products/services).

Regarding claim 46, its limitations are already covered in the analysis of claim 39 above. Abelow teaches using/evaluating [corresponds to estimating] prior use information from the customer/buyer in redesigning and improving the services and products offered to the buyer/customer.

Regarding claims 54 and 58 their limitations are closely parallel to the limitations of claim 39 and are therefore analyzed and rejected on the basis of same rationale set forth for claim 39 above.

Regarding claim 55, Walker discloses a database in communication with the server (see fig.3. Data storage device 330 in communication with server 300 wherein the database device 330 can store buyer's requests [CPO], buyer data, qualification data and seller data [carrier].

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zhu (US Patent 6,240,172, see at least col.1, line 41-col.2, line 50) and Glitho et al. (US Patent 5,999,973, see at least col.2, lines 4-14) disclose buying and selling telecommunication services by consumers and service providers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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Application/Control Number:  
09/390,026  
Art Unit: 3625

Page 11



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Art Unit 3625

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11/30/2007